

REMARKS

This Replacement Amendment is responsive to the Notice of Non-Compliant Amendment mailed February 8, 2007, and also to the non-final Office Action mailed June 2, 2006.

The Applicant again thanks the Examiner for conducting a telephonic interview with Applicant's attorney, Marvin Glazer, on July 13, 2006, to discuss this application. During such interview, Applicant's attorney discussed a proposed amendment to claim 155 to overcome the Examiner's rejection under Section 112, second paragraph. Specifically, Applicant's attorney proposed amending claim 155 to substitute, within sub-paragraph a), "storing recipient data pertaining to an actual recipient" [of an e-mail message] in place of "storing recipient data pertaining to at least one party"; and substituting "said stored recipient data identifying said actual recipient" in place of "said stored recipient data identifying said at least one party." In addition, within sub-paragraph d), Applicant's attorney proposed inserting "... and discovering the stored recipient data that identifies the actual recipient". During such telephonic interview, the Examiner indicated that such revisions to claim 155 would obviate the Section 112 rejection directed against such claim.

During the Examiner Interview, Applicant's attorney also discussed the rejection under Section 103(a) of claims 155 and 244. Applicant's attorney argued that the cited patents to Choi (U.S. Patent No. 6,629,131) and Flynn (U.S. Patent No. 6,618,747) do not, either separately or in combination, disclose or suggest discovering stored recipient data that identifies the recipient of an e-mail message. The Examiner and Applicant's attorney were not able to reach agreement on this point during such telephonic interview.

During the Examiner Interview, Applicant's attorney also discussed the rejection under Section 103(a) of claims 236 and 248. Applicant's attorney argued that the cited patents to Choi (U.S. Patent No. 6,629,131) and Flynn (U.S. Patent No. 6,618,747) do not, either separately or in combination, disclose or suggest the prompting of the person seeking access to an e-mail message to first enter identifying recipient data before being provided access to such message. Once again, the Examiner and Applicant's attorney were not able to reach agreement on this point.

1 Also during the Examiner Interview, Applicant's attorney discussed with the Examiner the
2 rejection under Section 103(a) of claim 252, relating to the use of biometrics. Applicant's attorney
3 argued that the cited patents to Choi (U.S. Patent No. 6,629,131) and Flynn (U.S. Patent No.
4 6,618,747) do not, either separately or in combination, disclose or suggest the use of biometrics data
5 to identify the recipient of an e-mail message. The Examiner agreed that neither Choi nor Flynn
6 taught this aspect of Applicant's invention. However, the Examiner did not indicate that claim 252
7 is patentable; rather, the Examiner indicated that he would like to continue his search of the art.

8
9 Rejection of Claim 155 Under Section 112, 2nd Paragraph

10 As indicated above, claim 155 was rejected in the non-final Office Action (the Office Action
11 actually referred to "claim 1", but the Examiner clarified during the Examiner Interview that such
12 rejection was really directed to claim 155) under 35 U.S.C. §112, 2nd paragraph, as being indefinite.
13 In particular, the Examiner noted that sub-paragraph (a) of claim 155 did not clearly identify which
14 "party" was being referenced within the phrase "storing recipient data pertaining to at least one
15 party ...". Claim 155 has been amended above, and within sub-paragraph a), the phrase "storing
16 recipient data pertaining to an actual recipient of e-mail in a data file" has been substituted in place
17 of "storing recipient data pertaining to at least one party". Sub-paragraph a) of claim 155 has also
18 been amended to substitute the phrase "said stored data file containing identifying data that
19 identifies said actual e-mail recipient" in place of "said stored recipient data identifying said at least
20 one party." In addition, sub-paragraph d) of claim 155 has been amended to parallel the
21 amendments made in sub-paragraph a). Applicant respectfully submits that these amendments
22 clarify any indefiniteness that previously existed within claim 155, and that the rejection of claim
23 155 under Section 112, 2nd paragraph, has been obviated.

24
25 Section 103(a) Rejections:

26 The Examiner rejected all of the previously-pending claims 155-255 as describing subject
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1 matter which the Examiner considered to differ in only obvious ways from Flynn and Choi.
2 Applicant respectfully requests reconsideration of such rejections in view of the above claim
3 amendments, and in light of the following remarks.

4
5 Independent Claims 155, 244, 256, 257:

6 Method claims 155, 256, and 257 all include the step of storing recipient data pertaining to
7 a recipient of e-mail in a data file. The stored data file contains data that identifies the e-mail
8 recipient, and which is associated with the recipient's email address. Upon detecting an access
9 event, the stored data file is discovered. At least a portion of such identifying data is then sent to
10 confirm proper delivery of the e-mail.

11 System claim 244 similarly recites a data file stored on a recipient computer associated with
12 e-mail retrieval recipient of an e-mail message, and identifying a party associated with a particular
13 e-mail address. The system includes software capable of detecting an access event and discovering
14 the stored data file that identifies the recipient of the e-mail message. The system sends the
15 discovered stored data file for confirming proper delivery of the e-mail.

16 In rejecting the claims, the Examiner commented in the non-final Office Action that the
17 cited patent to Choi "disclosed a method ... comprising storing recipient data pertaining to at least
18 one party on a computer associated with said at least one party for purposes of retrieving email, said
19 stored recipient data identifying said at least one party (col. 1, lines 36-53). The portion of Choi's
20 patent specification (i.e., col. 1, lines 36-53) referenced by the Examiner describes a "unique code"
21 given to each mail sent by a sender. Choi explains that such "unique code" is recorded in a
22 database. However, the aforementioned "unique code" is generated at the sender end, and does not
23 identify the recipient who accessed the email message at the receiving end. In no sense does the
24 "unique code" identify the person/company who actually received the email message. Indeed, at
25 page 3 of the non-final Office Action, the Examiner admits that "Choi did not explicitly disclose d)
26 detecting an access event, and discovering the stored recipient data that identifies the recipient ...".
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1 On page 3 of the non-final Office Action, the Examiner contends that “Flynn disclosed ...
2 detecting an access event, and discovering the stored recipient data that identifies the recipient ...”;
3 in support of such conclusion, the Examiner references col. 6, lines 53-56 of Flynn. The cited
4 portion of Flynn merely states the following:

5 “The recipient requests the message data-string located at the provided unique call address
6 and it is sent to the recipient, who downloads it, opening it.” (Col. 6, lines 53-56).

7 Flynn notifies an intended recipient that an email message has been posted and waits for the
8 intended recipient to request the message; when such request is received, a confirmation notice is
9 sent to the sender to confirm that the message was downloaded. Flynn describes the transmission,
10 from the sender’s end, of a “unique call address” (assigned by Flynn’s Web Server 24) to access an
11 e-mail message stored at such unique call address on the Web server. Such “unique call address”
12 does not itself identify the intended recipient. When the email message is downloaded, Flynn’s
13 system sends a confirmation of receipt notice that includes “the address to which the email was
14 downloaded, the time it was downloaded, and optionally, a compressed copy of the original
15 message.” However, this information does not identify the recipient who accessed the e-mail
16 message. It certainly does not contain a previously-stored data file that identifies the recipient.

17 Accordingly, even if the teachings of Flynn are combined with the email confirmation
18 system disclosed by Choi, the combination does not teach or suggest the method recited by claims
19 155, 256, and 257, nor the system recited by claim 244.

20
21 Rejection of Claims 236 and 248 Under Section 103(a)

22 As amended above, pending independent method claims 236 and 258 both include the step
23 of detecting an access event, and prompting the party who triggered the access event to enter
24 recipient data prior to allowing the requested access, wherein the recipient data either relates to, or
25 is associated with, the recipient who triggered the access event. Both claims 236 and 258 further
26 recite the step of sending recipient data for confirming proper delivery of the e-mail.

1 System claim 248 recites a system that includes software capable of detecting an access
2 event, and prompting the party triggering such access event to input recipient data prior to allowing
3 the requested access. The recited system sends the recipient data for confirming proper delivery of
4 the e-mail.

5 While the Examiner rejected claims 236 and 248 as being considered obvious from Choi and
6 Flynn, the Examiner fails to explain how Choi prompts the party who triggered an access event to
7 enter recipient data that identifies the party who triggered the access event. Choi does not prompt
8 the potential recipient to enter any data at all. The only data mentioned by Choi is the “unique
9 code” assigned to the email message by the sending end, and this “unique code” is not equivalent to
10 recipient data that identifies the person or company who triggered the access event. Likewise, the
11 Examiner has not explained how Flynn prompts the party who triggered an access event to enter
12 recipient data that identifies the person/company who triggered the access event. While Flynn sends
13 a notice to a recipient regarding the posting of a message on a server, Flynn does not prompt the
14 party who triggered the access event to enter any recipient data that identifies the person/company
15 who triggered the access event.

16 As neither Flynn nor Choi, separately or in combination, disclose or suggest prompting a
17 party requesting access to an e-mail to enter recipient data after detecting an access event, method
18 claims 236 and 258, and system claim 248, are patentably distinguishable from the cited references.

19
20 Rejection of Biometrics Claims Under Section 103(a)

21 Previously, independent method claims 208 and 237, and system claim 252 were addressed
22 to the use of biometrics to identify the recipient of an e-mail message. The claims have been
23 amended above, and now, independent method claims 260, 264, and 268 address acquiring recipient
24 data related to biometric identification of the recipient; identifying a recipient utilizing biometric
25 identification; and identifying a recipient in association with biometric identification, respectively.
26 In each case, the method includes sending data that identifies the recipient for confirming proper
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1 delivery of said e-mail.

2 System claim 252 recites, among other things, "biometric identification means" for
3 recognizing biometric attributes of an individual; software capable of detecting an access event and
4 identifying an individual through utilization of inputted biometric attributes of said individual; and
5 "means for sending data" that identifies such individual for confirming proper delivery of the e-
6 mail. As noted above relative to the telephonic interview with the Examiner, neither Choi nor
7 Flynn suggests, or even mentions, the use of biometric information as a technique for identifying a
8 recipient of an e-mail.

9
10 **New Independent Method Claims 272 and 341, and New Independent System Claim 278**

11 New method claims 272 and 341 each relate to a method for verifying whether an e-mail
12 sent by a sending party was accessed by an intended recipient. The method includes the step of
13 storing recipient data on a storage element of a computer used to access e-mail, and wherein the
14 recipient data includes identifying data that is associated with a recipient of e-mail. The method
15 further includes the step of detecting an access event and discovering at least part of the stored
16 recipient data that is associated with the recipient. At least a part of the discovered recipient data is
17 sent for confirming proper delivery of the e-mail.

18 Similarly, in new system claim 278, a system for verifying whether e-mail sent by a sending
19 party was accessed by an intended recipient includes a recipient computer capable of receiving the
20 transmitted e-mail and further having a data storage. Recipient data is stored on the data storage of
21 the computer used by the recipient to access e-mail. This recipient data includes identifying data
22 that is associated with the recipient. The system includes software capable of detecting an access
23 event, and upon detecting such an access event, the software discovers at least part of the stored
24 recipient data associated with the recipient. The system also sends at least part of the discovered
25 recipient data for confirming proper delivery of the e-mail.

1 Once again, neither of the cited references to Choi or Flynn teach or suggest this aspect of
2 Applicant's invention. Within the Office Action, the Examiner has already conceded that "Choi did
3 not explicitly disclose d) detecting an access event, and discovering the stored recipient data that
4 identifies the recipient ...". Furthermore, Applicant has already pointed out above that the portion of
5 the Flynn patent specification relied upon by the Examiner, i.e. col. 6, lines 53-56 of Flynn, merely
6 notifies an intended recipient that an email message has been posted and waits for the intended
7 recipient to request the message; when such request is received, a confirmation notice is sent to the
8 sender to confirm that the message was downloaded. Flynn describes the transmission, from the
9 sender's end, of a "unique call address" (assigned by Flynn's Web Server 24) to access an e-mail
10 message stored at such unique call address on the Web server. Such "unique call address" does not
11 itself identify the intended recipient. When the email message is downloaded, Flynn's system sends
12 a confirmation of receipt notice that includes "the address to which the email was downloaded, the
13 time it was downloaded, and optionally, a compressed copy of the original message." However, this
14 information does not identify the recipient who accessed the e-mail message. It certainly does not
15 contain a previously-stored data file that identifies the recipient who caused the e-mail to be
16 accessed.

17 Accordingly, the cited references to Choi and Flynn do not teach or suggest to those skilled
18 in the art Applicant's novel method as set forth, for example, in method claims 272 and 341.
19 Similarly, the combination of elements set forth in new independent system claim 278 is not
20 anticipated or rendered obvious in view of the cited prior art.

21 **Conclusion**

22 In view of the amendments to the claims made herein, and in light of the above remarks,
23 Applicant respectfully submits that the patent claims now pending define subject matter that is
24 patentably distinguishable from the prior art, and Applicant requests that the present application
25 now be allowed.

Respectfully submitted,

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